

REMARKS

The Applicant has studied the Office Action dated March 20, 2007. Claims 31 and 32 have been canceled without prejudice. Claim 33 has been added. Claims 12-30 and 33 are pending in the application. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks are respectfully requested.

In the Office Action, the Examiner:

- (1-2) Objected to the specification for informalities;
- (3-4) Objected to the drawings;
- (6) Objected to claims 26-27 and 31-32 under 37 CFR 175(c) as being of improper dependent form;
- (7-10) Rejected claims 12-32 under 35 U.S.C. 112, ¶ 2, as being indefinite;
- (11-12) Rejected claims 12-14, 16, 18, 20, 22-, 24-25, and 30 under 35 U.S.C. § 102(b) as being anticipated by Grant (US 6,601,651);and
- (13-15) Rejected claims 15, 17, 19, 21, 23, and 28-29 under 35 U.S.C. § 103(a) as being unpatentable over Grant (US 6,601,651) in view of Conry (US 5,857,348).

(1-2) Objection to the specification for informalities

The Applicant wishes to thank Examiner for pointing out the informality with the specification. As suggested by the Examiner, the specification has been amended to correct both the section headings and the priority date for a foreign application. No new matter has been added. Accordingly, the Applicant respectfully submits that the Examiner's objection to the specification has been overcome and should be withdrawn.

(3-4) Objection to the Drawings;

The Applicant wishes to thank Examiner pointing out the informality with FIG. 3. Two changes to FIG. 3 were made: The first change is to insert reference numeral 306 to proper refer to the "stator" to correspond to the accompanying description in the text. The second change is to delete the reference L2. In addition the specification at the paragraph on page 10 being on line 14 has been amended to clarify the flow path of L1 is represented in FIG. 3 by a chain-dotted line. This is shown in the substitute specification. No new matter has been added. Accordingly, the Applicant respectfully submits that the Examiner's objection to the drawings has been overcome and should be withdrawn.

(6) Objection To Claims As Being Of Improper Dependent Form

As noted above, the Examiner objected to claims 26-27 and 31-32 under 37 CFR 175 (c) as being of improper dependent form. Claims 26-27 have been carefully amended to depend from claims 12 and 14 respectively. Claims 31 and 32 have been cancelled without prejudice or disclaimer, rendering this objection moot. Accordingly, the Applicant respectfully submits that the Examiner's objection to claims 12 and 14 has been overcome and should be withdrawn.

(7-10) Rejected Claims 12-32 Under 35 U.S.C. 112, ¶ 2, As Being Indefinite

As noted above, the Examiner rejected claims 12-32 under 35 U.S.C. 112, ¶ 2, as being indefinite. Specifically, independent claim 12 has been amended to positively recite the auxiliary compressor as suggested by the Examiner. Claims 24 and 25 have been amended to eliminate the term "essentially". Accordingly, the Applicant respectfully submits that the Examiner's rejection to claims 12-32 has been overcome and should be withdrawn.

(11-12) Rejection under 35 U.S.C. §102(b)

As noted above, the Examiner rejected claims 12-14, 16, 18, 20, 22-, 24-25, and 30 under 35 U.S.C. § 102(b) as being anticipated by Grant (US 6,601,651). Independent claim 12 has been carefully amended to distinguish over Grant. Specifically, the present invention has an auxiliary compressor that is located down the hole with the compressor apparatus. Independent claim 12, recites inter alia:

at least one auxiliary compressor mounted on the downstream end of the rotor so that the auxiliary compressor draws from down stream the bladed impeller wheel and pressurizes the gas before supplying the gas to the bearings of the rotor;

wherein all the gas bearings of the auxiliary compressor and of the electric motor are arranged on a same side of the bladed impeller wheel; and during operation, the gas flows over to cool the electric motor.

Grant specifically teaches away from the "auxiliary compressor mounted on the downstream end of the rotor." In contrast, the auxiliary compressor 38 of Grant is located outside the hole, above-the-ground. See Grant FIG. 1. The present invention eliminates the need for the annulus 24, in the coiled tubing 44, to the motor 30 and compressor 32. See Grant FIG. 1 and col. 3, lines 51-61.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Grant. See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Because the elements in independent claim 12 of "at least one auxiliary compressor mounted on the downstream end of the rotor so that the auxiliary

compressor draws from down stream the bladed impeller wheel and pressurizes the gas before supplying the gas to the bearings of the rotor" and "wherein all the gas bearings of the auxiliary compressor and of the electric motor are arranged on a same side of the bladed impeller wheel" is not taught or disclosed by Grant. The auxiliary compressor of Grant can not be mounted on the downstream end of the rotor. Accordingly, the present invention distinguishes over Grant for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

Independent claim 12 has been amended to distinguish over Grant. Claims 13-30, depend from independent claim 12. Since dependent claims contain all the limitations of the independent claims, claims 13-30 distinguish over Grant, as well and the Applicant respectfully submits that the Examiner rejection has been overcome and should be withdrawn.

Rejection under 35 U.S.C. §103(a)

As noted above, the Examiner rejected claims 15, 17, 19, 21, 23, and 28-29 under 35 U.S.C. § 103(a) as being unpatentable over Grant (US 6,601,651) in view of Conry (US 5,857,348). The Examiner goes on to combine Grant with Conry. Applicant makes no statement whether such combination is even proper. For reasons stated above in the section entitled "Rejection under 35 U.S.C. §102(b)", Grant taken alone and/or in view of Conry are silent on the elements of amended independent claim 12 "at least one auxiliary compressor mounted on the downstream end of the rotor so that the auxiliary compressor draws from down stream the bladed impeller wheel and pressurizes the gas before supplying the gas to the bearings of the rotor" and "wherein all the gas bearings of the auxiliary compressor and of the electric motor are arranged on a same side of the bladed impeller wheel." Accordingly, independent claim 12, as amended of the present invention distinguishes over Grant taken alone and/or in view of Conry for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35

U.S.C. § 103(a) has been overcome. Independent claims 12 has been amended to distinguish over Grant taken alone and/or in view of Conry. All the remaining claims ultimately depend on amended independent claim 12 since dependent claims contain all the limitations of the independent claims, all the remaining claims distinguish over Grant taken alone and/or in view of Conry for at least this reason, as well and the Examiner's rejection should respectfully be withdrawn.

Further, the Applicant submits that the combination of Grant with Conry is inoperable and hence teaches away from Grant specifically teaches away from the "auxiliary compressor mounted on the downstream end of the rotor." In contrast, the auxiliary compressor 38 of Grant is located outside the hole, above-the-ground. See Grant FIG. 1. The present invention eliminates the need for the annulus 24, in the coiled tubing 44, to the motor 30 and compressor 32. See Grant FIG. 1 and col. 3, lines 51-61. Where the prior art points away from the combination, modification or substitution of which is the premises of the PTO's alleged prima facie case of obviousness, there likewise is a built-in traversal of the rejection. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

CONCLUSION

The prior art made of record and not relied upon was reviewed and the Applicant believes that such prior art is not pertinent to Applicant's disclosure.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The applicant acknowledges the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

The Commissioner is hereby authorized to change any fees that may be required or credit any overpayment to Deposit Account 50-1556. In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

PLEASE CALL the undersigned if the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application.

Respectfully submitted,

Date: July 20, 2007

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